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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/324,601	06/02/1999	STEVEN C. ROBERTSON	ROBERT.P001	1766

EXAMINER
FADOK, MARK A

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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MAR 27 2008

TECHNOLOGY CENTER 3600

PATRICK M. DWYER PC
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SEATTLE WA 98133

In re Application of: Steven C. ROBERTSON
Application No. 09/324,601
Filed: June 2, 1999
For: SYSTEM AND METHOD FOR
PROVIDING ELECTRONIC MULTI-
MERCHANT GIFT CERTIFICATE &
CONTRIBUTION BROKERING
SERVICES OVER A DISTRIBUTED
NETWORK

**DECISION ON PETITION
FILED UNDER
37 CFR 1.198**

This decision is in response to the petition filed on February 15, 2008 entitled "Petition Under 37 CFR 1.198".

The petition is DENIED.

File History

The Board of Patent Appeals and Interferences (hereafter: "BPAI") mailed a first "Decision on Appeal" (hereafter: "First Decision") on August 20, 2007. The First Decision sustained the rejection of claims 23-37 under 35 USC 102(e) as anticipated by Gillin. No claims stood allowed.

Appellant, in response to the First Decision, filed a "Request for Rehearing" (hereafter: "Request for Rehearing") as well as a "Petition under 37 CFR 1.198" (hereafter: "First Petition"). The Request for Rehearing and the First Petition were filed, concurrently, on October 19, 2007. The First Petition was accompanied by a proposed amendment to claims 23, and 29-35.

A "Decision on Petition to Reopen Prosecution after Board Decision under 37 CFR 1.198" (hereafter: "First Decision on Petition") was mailed December 5, 2007. The First Decision on Petition held the First Petition as being dismissed because the First Petition was considered premature inasmuch as it was filed prior to the decision on appeal having become final for judicial review.

The BPAI mailed a second "Decision on Appeal" (hereafter: "Second Decision") on January 16, 2008. The Second Decision again sustained the rejection of claims 23-37 under 35 USC 102(e) as anticipated by Gillin. No claims stood allowed.

Appellant filed a "Request for Reconsideration of Petition under 37 CFR 1.198" (hereafter: "Second Petition") on January 17, 2008.

A second Decision on Petition (hereafter: "Second Decision on Petition") (forthcoming) separately treats the Second Petition as a petition seeking reconsideration of the dismissal of the First Petition based upon a holding that the First Petition was filed prematurely. The Second Decision on Petition notes that the Second Petition, although submitted subsequent to the mailing of the Second Decision, is not considered to be a resubmission of the Petition under 37 CFR 1.198 as advised in the First Decision on Petition.

Appellant filed a "Petition Under 37 CFR 1.198" (hereafter: Instant Petition) on February 15, 2008. The Instant Petition was accompanied by a proposed amendment to claims 23, and 29-31, 33-35.

The Instant Petition

The Instant Petition requests the reopening of prosecution of this application after a decision by the BPAI based upon the argument that:

"[T]he Board maintained that rejection of claims 23-37 was proper because the claims do not include particular limitation(s). The decision reasonably is suggestive that claims including the disclosed limitation would distinguish over the cited art." (Instant Petition at page 1)

37 CFR 1.198 states:

"When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown."

37 CFR 41.50(c) states:

"The opinion of the Board may include an explicit statement of how a claim on appeal may be amended to overcome a specific rejection. When the opinion of the Board includes such a statement, appellant has the right to amend in conformity therewith. An amendment in conformity with such statement will overcome the specific rejection. An examiner may reject a claim so-amended, provided that the rejection constitutes a new ground of rejection."

It is noted that the decision on appeal has now become final for judicial review as of the mailing of the Second Decision.

The Instant Petition cites numerous instances in which the BPAI states that certain limitations argued by Appellant were not found to be actual claim limitations in their review of the claims on appeal. The Instant Petition seeks to add such disclosed limitations to the language of the claims and asserts that the proposed claim language for entry under 37 CFR 1.198 was either “suggested” or “reasonably suggested” by the BPAI in both the First Decision and Second Decision as limitations which, if claimed, would distinguish over Gillin and would provide claims which would “now be allowable” (see Instant Petition at page 3, first indent; at page 5, first full indent; and at page 6, first two full indents).

A review of the First Decision and the Second Decision reveals that nowhere in either Decision does the BPAI make any explicit statement of how a claim on appeal may be amended to overcome a specific rejection. The Instant Petition cites to the First Decision at page 9, lines 11-16; page 16, last paragraph; at page 17, first paragraph; page 11, lines 4-6; and page 16, lines 17-23. The Instant Petition also cites to the Second Decision at page 2, lines 5-12; page 4, lines 3-18. However, it is clear from the analysis at these cites that the BPAI considers Appellant’s arguments directed to unrecited language to be unpersuasive because the arguments are not commensurate with the actual claim language. None of these cites contains an explicit statement that the rejection would be overcome if amended to include the unrecited language. A thorough review of the First Decision does not reveal any such explicit statement by the BPAI. Additionally, a similar review of the Second Decision does not reveal any such explicit statement by the BPAI.

A “suggestion” or “reasonable suggestion” that Appellant amend, as offered by the Instant Petition, does not rise to the level of “explicit statement” required by 37 CFR 1.198. Notwithstanding this, however, it is not viewed that either the First Decision or the Second Decision even “suggested” or “reasonably suggested” that an amendment to include the unrecited claim limitations discussed would do anything more than permit Appellant’s arguments to be viewed as commensurate with the language of the claims on appeal.

Consideration for Entry of an Amendment Pursuant to MPEP 1214.07

The proposed amendment is NOT ENTERED.

Consideration to the entry of the amendment proposed in the Instant Petition has been given pursuant to MPEP 1214.07.

MPEP 1214.07 states (in pertinent part):

“Sometimes an amendment is filed after the Board’s decision which does not carry into effect any recommendation made by the Board and which presents a new or amended claim or claims. In view of the fact that prosecution is closed, the appellant is not entitled to have such amendment entered as a matter of right.”

“If the amendment obviously places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner should recommend that the amendment be entered, and with the concurrence of the supervisory patent examiner, the amendment will be entered.”

A review of the amendment does not reveal that the entry of such amendment will clearly place the application in condition for allowance. Again, the entry of such amendment would merely permit Appellant's arguments of-record to be viewed as commensurate with the new language of the claims. It is further noted that the proposed amendment has not been submitted pursuant to 37 CFR 1.121 inasmuch as the proposed amendment at least does not include the required status identifiers.

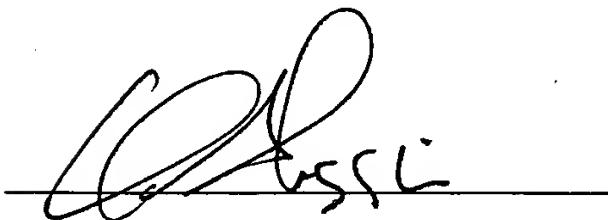
The amendment filed with the Instant Petition after a decision by the BPAI is not entered because prosecution is closed and the proposed amendment was not suggested in an explicit statement by the Board under 37 CFR 41.50(c). As provided in 37 CFR 1.198, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner after a final decision of the Board except under the provisions of 37 CFR 1.114 (request for continued examination) or 37 CFR 41.50 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Summary

The Instant Petition is DENIED.

The proposed amendment filed with the Instant Petition is NOT ENTERED pursuant to either 37 CFR 1.198 or MPEP 1214.07.

Telephone inquiries should be directed to Jeffrey A. Smith, Supervisory Patent Examiner, at (571) 272-6763.

A handwritten signature in black ink, appearing to read 'Wynn Coggins', is written over a horizontal line.

Wynn Coggins, Director
Patent Technology Center 3600
(571) 272-5350

WC/jas: 03/04/2008

TL